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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/540,699 | 06/24/2005 | Josephus Arnoldus Henricus Maria Kahlman | NL 021503 | 8950 |
| 24737 | 7590 | 09/29/2008 | EXAMINER | |
| PHILIPS INTELLECTUAL PROPERTY & STANDARDS | | | JACKSON, STEVEN L | |
| P.O. BOX 3001 | | | ART UNIT | PAPER NUMBER |
| BRIARCLIFF MANOR, NY 10510 | | | 4134 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/540,699 | KAHLMAN ET AL. |
| | Examiner | Art Unit |
| | STEVEN L. JACKSON | 4134 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06/24/2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-9 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 24 June 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>09/11/2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: description of drawings in the section labeled “Brief Description of the Drawings” does not match the drawings. An example: Figure 2 is associated with two drawings (Figure 2a and Figure 2b); however, the drawing description only relates to Figure 2. Further example: Figure 5 is included as a drawing; however, Figure 5 is not described in the “Brief Description of the Drawings”.

Appropriate correction is required.

Drawings

2. Figure 1a should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, 2164.08(a) - Single Means Claim. A single means claim, i.e., where a means recitation does not appear in combination with

another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1- 6 and 8 - 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No 6438084 to *Kawashima et al.*

As to claim 1, *Kawashima et al* discloses a record carrier (normal-density CD-R) intended to store data, characterized in that data is intended to be stored in accordance with a standard for creating physical data clusters separated by protective linking areas, said protective linking areas being of different size from linking areas of a writable record carrier (double-density CD-R) intended to store said physical data clusters locked to a pre-recorded wobbled groove (Column 8, lines 53 – 61; Figure 1; Figure 2) in which linking areas are used. Refer to the Abstract. In particular, either a normal-density CD-R or a double-density CD-R can be read

as the record carrier, the other being read as the "writable record carrier". Data which can be stored on a CD-R can also be stored on a double-density CD-R and vice versa (with respect to capacity limits in the latter scenario). Linking areas of a normal-density CD-R differ in size from those of a double-density CD-R (two run-in blocks vs. three run-in blocks respectively).

As to claim 2, *Kawashima et al* further discloses a record carrier as disclosed in the parent claim, wherein said record carrier is an optical disc. Refer to column 1, lines 8 – 11.

As to claim 3, *Kawashima et al* further discloses a record carrier (normal-density CD-R) as disclosed in the parent claim, wherein said protective linking areas of said record carrier are shorter than linking areas of the writable record carrier (double-density CD-R). Refer to the Abstract. In particular, the normal-density CD-R is read as the record carrier and the double-density CD-R is read as the writable record carrier. The linking area of the normal-density CD-R is one run-in block shorter than the linking area of the double-density CD-R.

As to claim 4, *Kawashima et al* further discloses a record carrier (double-density CD-R) as disclosed in the parent claim, wherein said protective linking areas of said record carrier are longer than linking areas of the writable record carrier (normal-density CD-R), data essential for playability of said record carrier being stored in said protective linking areas of said record carrier. Refer to the Abstract. In particular, the double-density CD-R is read as the record carrier and the normal-density CD-R is read as the writable record carrier. The linking area of the double-density CD-R is one run-in block longer than the linking area of the normal-density CD-R. Applicant discloses in ¶0023 and ¶0024, that data essential to the playability of said record carrier is located within the data linking blocks. In particular, information stored in the

field PRA serves as a means of locking and synchronization of the signal processing without which the physical cluster would not be read as valid data.

As to claim 5, *Kawashima et al* further discloses a record carrier as disclosed in the parent claim, wherein said record carrier is another writable record carrier of a different standard. Refer to Abstract. In particular, the normal-density CD-R is a different hardware standard from the double-density CD-R hardware standard. Further, Refer to column 2, lines 40 – 53; column 4, lines 38 – 42.

As to claim 6, *Kawashima et al* further discloses a record carrier as disclosed in the parent claim, wherein said record carrier is a pre-recorded record carrier including original data. Refer to column 2, lines 40 – 53. In particular, once data is recorded to the record carrier it can be subsequently considered as a pre-recorded record carrier including original data. It is also well known to one of skill in the art that both normal-density CD-R's as well as double-density CD-R's are used for the storage and distribution of data by companies in which case, the normal-density or double-density CD-R is pre-recorded with original data.

As to claim 8, *Kawashima et al* discloses a pre-recorded record carrier manufacturing apparatus (data recording apparatus), characterized in that said apparatus comprises means for forming recording unit blocks with protective linking areas between physical clusters of data; said linking areas being of different size from linking areas of a (re-)writable record. Refer to column 2, line 54 - column 3, line 9.

As to claim 9, *Kawashima et al* further discloses a pre-recorded record carrier manufacturing method, characterized in that said method comprises a step of forming recording unit blocks with protective linking areas between physical clusters of data, said linking areas

being of different size from linking areas of a writable record carrier intended to store said physical data clusters locked to a pre-recorded wobbled groove in which linking areas are used. Refer to column 2, lines 40 – 53. In particular, once data is recorded to the record carrier it can be subsequently considered as a pre-recorded record carrier including original data. It is also well known to one of skill in the art that both normal-density CD-R's as well as double-density CD-R's are used for the storage and distribution of data by companies in which case, the normal density or double-density CD-R is pre-recorded with original data.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No 6438084 to *Kawashima et al* in view of EP 0899733 A1 to *Blaukovitsch*.

As to claim 7, *Kawashima et al* discloses a record carrier as recited in the parent claim. *Kawashima et al* does not expressly disclose a record carrier which also implements a protection using a hidden key.

Blaukovitsch discloses a record carrier which implements a protection method using a hidden key as applicant discusses in Paragraph 2 ("Background of the Invention") of the specification.

Kawashima et al and *Blaukovitsch* are analogous art because they are from the same field of endeavor with respect to protecting data on a disk from being copied onto a second disk.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify a record carrier with linking areas being of different size than those of a writable record carrier to include use of hidden keys. The suggestion/motivation would have been in order to provide a means of preventing data on a record carrier of the type disclosed in *Kawashima et al* from being copied to a second record carrier.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN L. JACKSON whose telephone number is (571) 270-7364. The examiner can normally be reached on Monday through Thursday, 8:00 AM until 5:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lun-Yi Lao can be reached on (571) 272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/STEVEN L JACKSON/
Examiner, Art Unit 4134

/LUN-YI LAO/
Supervisory Patent Examiner, Art Unit 4134